

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
Appln. No.: 09/834,639

REMARKS

Claims 1-22 are pending in the application. Claims 1-3, 7-12 and 16-18 are withdrawn from consideration.

I. The Information Disclosure Statement

Filed concurrently herewith is an Information Disclosure Statement (IDS). The Examiner is requested to acknowledge receipt of the IDS and return an initialed copy of the form PTO/SB/08.

II. Claims 19-22

In Paragraph 3 of the Office Action dated April 30, 2003, the Examiner states that she does not view claims 19-22 as requiring the choice of a specific compound of formula (I-1) to (I-4). As an example of her position, the Examiner states that "when formula (I-1) is chosen in instant claim 1, the limitations of claims 20-22 are met." The Examiner also states that the rejections are based on that interpretation.

Applicants respectfully disagree with the Examiner's interpretation of claims 19-22. Claim 19 clearly recites the presence of general formula (I-1), claim 20 clearly recites the presence of general formula (I-2), claim 21 clearly recites the presence of general formula (I-3), and claim 22 clearly recites the presence of general formula (I-4). If, upon reconsideration, the Examiner maintains her position, the Examiner is requested to contact the undersigned Applicants' representative to discuss the scope of claims 19-22.

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III. The Rejection Under 35 U.S.C. §103(a)

Claims 4-6 and 13-15 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hasegawa et al.

Applicants respectfully submit that the present invention is not obvious over the disclosures of Hasegawa '898 and request that the Examiner reconsider and withdraw this rejection in view of the following remarks.

First, the Examiner states that the inventive resins used in the examples are not clearly identified and thus it is unclear which resins are being used in comparison to the prior art. In particular, the Examiner notes that the inventive resins are labeled (1)-(3) and (9). However, the Examiner states that the present specification discloses several different compounds referred to as resins (1), (2), (3) and (9).

As noted by the Examiner, the resins in the previous Declaration should not have been labeled (1) to (3) and (9), but rather should have been labeled (2-1), (2-2), (2-3) and (2-9). The resins (2-1), (2-2), (2-3) and (2-9) are described on pages 110 to 111 (the molar ratio and Mw thereof) and pages 62 to 64 (the structure thereof). However, the resin structures on pages 62 to 64 are mislabeled. Likewise, resins (1) to (12) described on pages 58 to 60 and resins (1) to (9) described on pages 66 to 67 are also mislabeled. In the present Amendment, for clarification, Applicants have amended the labels of the resin formulae of the present specification. For support

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for the changes, see the discussion on pages 101-102 and Table 1, pages 110-111 and Table 4 and pages 120-121 and Table 7 of the specification.

Additionally, filed herewith is a new §132 Declaration by Mr. Kenichiro Sato, the Declarant of the previous §132 Declaration, in which the resins used are clearly defined.

Second, the Examiner questions the choice of Polymer 35 of Hasegawa et al as the comparison polymer. The Examiner states that she believes a better comparison would have been with Polymer 34 of Hasegawa.

In the new §132 Declaration, Polymer (34) of Hasegawa is used for comparison, as requested by the Examiner. Additionally, Applicants respectfully submit that the samples with Polymer (35) are valid comparisons. The Polymer (35) contains a repeating unit having a group represented by Applicants' Formula (1-4) and thus is a valid polymer for comparison to the resins of the present invention.

In view of the above, Applicants respectfully submit that a direct comparison between the cited art and the claimed invention has been made in the new §132 Declaration. As set forth in further detail in the Declaration, by the use of the at least three types of claimed repeating units (general formula (I), general formula (NII) and one of general formulae (I-1)-(I-4)), unexpected improvements are

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achieved in the areas of edge roughness (ER) and in the number of development defects.

For the above reasons, it is respectfully submitted that the subject matter of claims 4-6, 13-15 and 19-22 is neither taught by nor made obvious from the disclosures of Hasegawa '898 and it is requested that the rejection under 35 U.S.C. §103(a) be reconsidered and withdrawn.

IV. Conclusion

In view of the above, Applicants respectfully submit that their claimed invention is allowable and ask that the rejection under 35 U.S.C. §103 be reconsidered and withdrawn. Applicants respectfully submit that this case is in condition for allowance and allowance is respectfully solicited.

If any points remain at issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local exchange number listed below.

Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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